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Dated: August 29, 2008

Signature: /Lynn L. Janulis/ 53,066
(Lynn L. Janulis)

Docket No.: 29636/39363A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jessberger et al.

Application No.: 10/570,047

Confirmation No.: 8165

Filed: February 28, 2006

Art Unit: 1635

For: Methods for Identifying, Treating, and Inducing
Infertility Using SMC1-Beta

Examiner: Dana Shin

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed February 29, 2008, Applicants hereby provisionally elect Group I (claims 1-2, 10-19, 29-32, 34-44, 48-49, and 134), with traverse.

Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all of the claims and at least the claims in Groups I-IV. M.P.E.P. § 803 provides:

If the search and examination of an application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction to be proper, the examiner must satisfy the following two criteria: (1) that independent and distinct inventions are being claimed (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. § 803.

The Examiner has not shown that it would be a serious burden to search and examine Groups I-IV together. Groups I-IV are all drawn to methods of inducing infertility in an animal comprising inhibiting SMC1 β expression or activity in said animal.

It is probable that a search based on agents that inhibit SMC1 β expression or activity will identify similar or the same art. Although the agents may not share a common structure, the agents act to inhibit polynucleotide or polypeptide expression. Existing search engines permit a searcher to search translations of the polynucleotide sequences of SMC1 β and permit rapid comparisons of polynucleotide and polypeptide databases. Thus, the search should uncover art relevant to all agents that inhibit SMC1 β polynucleotide and polypeptide expression, including antisense oligonucleotides, small molecule antagonists, peptidomimetic antagonists, and antibodies. Accordingly, because there would be no serious burden on the Examiner to search and examine Groups I-IV together, these groups should be examined simultaneously. In view of the foregoing, Applicants respectfully request that all claims in Groups I-IV be examined.

Applicants reserve the right to rejoinder of non-elected claims that depend from or otherwise require all the limitations of an allowable claim. See M.P.E.P. § 821.04. This response is timely filed along with a petition for an extension of time and the requisite fee.

Dated: August 29, 2008

Respectfully submitted,

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